



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Richard N. Terry)
Serial No. 09/461,846) Art Unit: 1714
Filed: December 15, 1999) Examiner: Peter A. Szekely
For: Polymer Compositions Containing)
Colloids of Silver Salts)

COMMENTS REGARDING REASONS FOR ALLOWANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits the following comments regarding the Examiner's Reasons for Allowance. First, this is not an appropriate case for use of Reasons for Allowance. Reasons for Allowance are only warranted in instances in which "the record of the prosecution as a whole does not make clear [the Examiner's] reasons for allowing a claim or claims." In the present case, Applicant believes the record as a whole does make the reasons for allowance clear and therefore no statement by the examiner is necessary or warranted. Furthermore, Applicant does not agree with all of the statements in the reasons for allowance. The Examiner has indicated that claims are allowed by using language and terms that are not part of the claims and thus provides reasons that are imprecise, inaccurate, and inconsistent with the correct interpretation of

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 28, 2004.


William K. McGreevey Reg. No. 52,012

ATLLIB02 149449.1

the claims. Such a characterization of the claims in view of the prior art does not properly take into account the Applicant's claimed invention as reflected in the claims, specification and the other information relevant to claim interpretation. Further examples of the concerns with the Reasons for Allowance appear below.

The Reasons for Allowance mailed October 28, 2003 state:

The references cited with PTO Form-1449 do not disclose two colloidal salts blended with a polymer or the same composition coated on a medical device or a blend of a colloidal salt and a polymer coated on an exposed surface of a medical device or a method of coating said compositions on said devices.

This statement also appeared in a Notice of Allowance mailed April 29, 2003. These reasons do not accurately describe the scope of the pending claims. The references to "two colloidal salts," is unduly limiting and inconsistent with the scope of the claims. First, the claims do not limit in any way the number of colloidal compounds in the compositions, articles, and methods of the invention. Rather, the claims describe the number of **oligodynamic** metal compounds that the colloid comprises. Further, some of the claims are not limited to embodiments involving colloids comprising oligodynamic salts, but rather describe the use of oligodynamic salts, oxides, or combinations thereof. (See, for example, Claim 1). In addition, even reference to "two" oligodynamic metal compounds would be unduly limiting as some claims describe a "plurality" of colloidal compounds and therefore cover a broader scope than the Examiner's reference to "two." Some claims describe use of "one or more" oligodynamic compounds (for example, Claim 43) and thus are not limited to "two" or to a plurality. In addition, the Examiner's discussion refers to "salts blended" with a polymer or to "a blend" of a colloidal salt and a polymer. The claims do not make any references to "blends" or "blending" whatsoever. The terms "blend" and "blending" are not part of the claims and are not relevant to their scope.

The Examiner also refers to certain compositions in coatings. Some claims are not limited to coatings or coating processes (for example, claims 13, 36, and 65). Finally, the Examiner's Reasons refer only to that which is disclosed upon "the references cited with PTO Form-1449." Applicant asserts that the claims are novel and nonobvious over all prior art and believes that this was the intent of the Examiner's conclusions.

An earlier Notice of Allowance mailed October 10, 2002 stated that:

None of the cited references disclose an article coated with a composition containing more than one oligodynamic [sic] metal compounds in a colloidal dispersion within a polymeric coating.

The words "colloidal dispersion" do not appear in any of the claims and are not relevant to the interpretation of the claims. As with the October 28, 2003 Reasons for Allowance, these reasons do not account for claims that are not limited to coatings or coating processes (for example, claims 13, 36 and 65) or for claims that describe "one or more" oligodynamic metal compounds (for example, claims 43 and 57). Finally, the Examiner's Reasons refer only to "the cited references." Applicant asserts that the claims are novel and nonobvious over all prior art and believes that this was the intent of the Examiner's conclusions.

Another Notice of Allowance, mailed April 17, 2002 stated that:

The references submitted with the International Search Report, either do not disclose a polymer in the coating or the coating is not on a medical device and contains only one colloidal salt.

This statement ignores claims that are not limited to a coating or coating process, as described above. Further, the claims do not limit in any way the number of colloidal compounds in the compositions, articles, or methods of the invention. Rather, the claims describe the number of oligodynamic metal compounds that the colloid comprises. In addition, as stated above, some of the claims are not limited to compositions, methods, or articles, involving oligodynamic metal

salts, but may involve oligodynamic metal salts, oligodynamic metal oxides, or combinations thereof. The Examiner's Statement also refers "only one" salt. The claims do not use the language "only one,"; rather, some claims more broadly describe "at least one" oligodynamic metal compound, and some describe a "plurality" of oligodynamic metal compounds. Finally, the Examiner's Reasons refer only to "references submitted with the International Search Report." Applicant asserts that the claims are novel and nonobvious over all prior art and believes that this was the intent of the Examiner's conclusions.

The foregoing reasons are simply examples of why the Applicants respectfully contend that the Examiner's Reasons for Allowance do not accurately describe the scope of the claims or all of the reasons why the claims are patentable. Applicants further contend that the claims are patentable over all prior art.

Respectfully submitted,



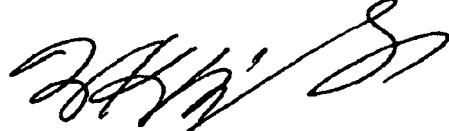
William K. McGreevey
Reg. No. 52,012

KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500
Our Docket: 02706-0520 (42276-210208)

Serial No. 09/461,846
Filed December 15, 1999
Information Disclosure Statement

charge any additional fees that may be required, or credit any overpayment, to Deposit
Account No. 11-0855.

Respectfully submitted,



By: William K. McGreevey
Reg. No. 52,012

KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500
Our Docket: 02706-0520 (42276-210208)